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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/035,522 | 11/09/2001 | Matthias Krull | 2000DE439 | 3068 |

7590

04/09/2003

Clariant Corporation
Industrial Property Department
4331 Chesapeake Drive
Charlotte, NC 28216

EXAMINER

MEDLEY, MARGARET B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1714

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-2

| | | | |
|------------------------------|---------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/035,522 | Applicant(s) KRULL ET AL. | |
| | Examiner Margaret B. Medley | Art Unit 1714 | |

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The pending claims are 1-11.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "B" in line 1 of claim 3 lacks support from claim 1 and renders the claim indefinite. The claim will be treated on the merits as the component being A. Clarification is requested.

Claim 10 recites a use without any reactive, positive steps delimiting how this use is actually practiced and therefore is indefinite. The claim will be treated on the merits as being "A method for enhancing the lubricity of middle distillates having a sulfur content of up to 0.05% by weight by adding the additive of the reaction ... 1-12 carbon atoms". Clarification to the record is requested.

Claim 3 recites the limitation "B" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 provides for the use of reaction product of A) and B), but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chandler 5,755,834 combined with Applicants' Admission.

Chandler teaches methods for enhancing the low temperature performance of fuels, column 2, lines 31-39 and column 10, lines 1-9 comprising concentrates wherein the fuel composition comprises a nitrogen-containing derivatives of a carboxylic acid as a wax modifier, an organic acid, and at least one flow improver. The nitrogen-containing compound are disclosed as being amine salts or amides formed by the reaction of hydrocarbyl amines including groups of straight or branched chain, column 2 lines 51-55 and 62-65, with hydrocarbyl acid having 1 to 4 carboxylic acid groups, columns 2 lines 51-55 and 62-65. The amines may be primary, secondary, tertiary or quaternary, column 3, lines 22-24. Further disclosed are amines of 12 to 22 carbon atoms, column 3, lines 25-45 and 60 to column 4 line 11, example 1 and claims 1, 7, 10 and 16 that rendered the instant claims obvious. It would be obvious to the artisan in the art to select branched and aliphatic amines depending on the desired end result effect to be achieved.

Applicants make admission on record at page 2 paragraph [006] that prior art Patent EP – 0,798,364 teaches salts and amides of mono- to tetra- carboxylic acids of 2-50 carbon atoms and aliphatic mono-/polyamines of 2 to 50 carbons are known lubricity enhancers for low sulfur diesel fuel. Preferred amines have 8 to 20 carbon atoms. The admitted prior provides the teaching that it would be reasonable obvious to the artisan in the art that amine salts and/or amides of Chandler would impact lubricity properties to low (0.05 %)sulfur fuel. It would be reasonable to the artisan in the art that the branched amines of Chandler would also impart lubricity properties to low sulfur

fuel, as well as, as other improved properties that branched chained amines have straight chained amines.


The prior art cited but not relied upon further teaches fuel compositions, additive and methods having additives of the same nature as those of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. B. Medley/mn
April 7, 2003


MARGARET MEDLEY
PRIMARY EXAMINER